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"request for package code"	to Shkedy's "sell order"
"shipping identifier"	to Shkedy's "buy order"
"associated address"	to Shkedy's "buy tracking identification"
"shipper"	to Shkedy's "intermediate"
"package code"	to Shkedy's "sell tracking identification"

CLAIM 1

Claim 1 is reproduced below:

A method of enabling anonymous shipment of a package containing goods purchased by a customer from a vendor for delivery to an address unknown to the vendor, comprising the steps of:

receiving a request for a package code for the package from the vendor;

sending the package code to the vendor, the package code being devoid of delivery address information and

sending a shipping identifier and an associated address to the shipper, whereby the shipper, after picking up the package for shipment from the vendor, matches the package code sent to the vendor with the shipping identifier and identifies the associated address as the delivery address of the package.

If one were to re-write independent claim 1 according to the substitutions suggested by the examiner, claim 1 would look like this:

A method of enabling anonymous shipment of a package containing goods purchased by a customer from a vendor for delivery to an address unknown to the vendor, comprising the steps of:

receiving a sell order for the package from the vendor;

sending the sell tracking identification to the vendor, the sell tracking identification being devoid of delivery address information and

sending a buy order and a buy tracking identification to the intermediate, whereby the intermediate after picking up the package for shipment from the vendor, matches the sell tracking identification sent to the vendor with the buy order and identifies the buy tracking identification as the delivery address of the package.

Such a claim does not make sense. In Shkedy, the sell tracking identification is an internal identifier that is used to track the sell order and the seller. A buy tracking identifier is also created,

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and used internally to keep track of a received buy order and the buyer. The Office would then have some undisclosed party send the sell tracking identification to the vendor - but never to the intermediate. The intermediate, according to the Office, should then match the sell tracking identification (which he has never received) with the buy tracking identification to determine the associated address.

MPEP section 706.02(j) contains the Office's own guidelines for rejecting claims based upon a combination of references under 35 USC §103:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). See MPEP § 2143 - § 2143.03 for decisions pertinent to each of these criteria.

At the outset, it is submitted that there is no suggestion or motivation to combine the two applied references:

No suggestion to modify or to combine the references

First, the Shkedy reference relates to selling (matching buyers and sellers) securities, and not to anonymous shipping. Moreover, whereas the secondary reference does relate to shipping, it does so differently than the present claimed invention. In *Wolinsky*, the parts are shipped to a central location, which is not the case the claims. There would be no motivation to combine methods of matching buyers and sellers with a centralized shipping scheme, as the buying and selling of securities is carried out electronically, which cannot be done when shipping parts, as in *Wolinsky*.

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No reasonable expectation of success

Second, there is clearly no reasonable expectation of success - as combining the references does not yield the present invention. Indeed, as noted above, the intermediate, according to the Office, should then match the sell tracking identification (which he has never received) with the buy tracking identification to determine the associated address. One of ordinary skill in the art, therefore, demonstrably would not have the requisite expectation of success. Combining the references leads to further incongruities, such receiving a sell order for the package from the vendor - why would the vendor send a sell order? A sell order is just that, an order to sell something. A buy order, moreover, is also just an order to sell something. These terms make sense in the context of Shkedy, which describes an anonymous marketplace for intangible and fungible goods (shares of mutual funds) where anonymous vendors are matched with anonymous buyers. This is done by matching sell order identifiers with matching buy order identifiers. This does not work, however, in the context of the present invention, in which the sale has already been consummated and all that remains to be done is for the seller to ship the purchased goods. The Examiner's proposed substitution "Sending a buy order ... to the intermediate" also is nonsensical. Why would a buy order be sent to the intermediate, who is presumably the shipper? It is clear that there can be no reasonable expectation of success in the present case - and hence no finding of obviousness.

Cited combination of references do not teach or suggest the claimed inventions

Third, it is also clear that the combination of references does not teach or suggest all of the limitations of the claimed inventions. In particular, the applied combination does not teach:

"receiving a request for a package code for the package from the vendor;"

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The passage referenced by the Examiner Col. 4, lines 46-49 as teaching this limitation does not teach receiving a request for a package code. Indeed, is wholly unreasonable to equate "receiving at the intermediate an order to sell shares of an investment company" with receiving a request for a package code. The plain meaning of the reference must be respected. No one (least of all the hypothetical person of ordinary skill in the art), without the benefit of hindsight, would think of a received order to sell shares of an investment company as somehow suggesting the step of receiving a request for a package code.

The cited combination also does not teach:

"sending the package code to the vendor, the package code being devoid of delivery address information and"

Indeed, the Office states that Shkedy does not teach this feature, but asserts that this feature is taught by Wolinsky. However, such is not the case. Wolinsky teaches only that components are first sent to "Fastparts in Elmhurst", and only after are the components sent to the buyer. There is simply no mention in Wolinsky that a package code is sent to the vendor. As noted above, the mere fact that Wolinsky teaches some form of anonymous shipment via a central location (unlike the present invention) does not, in itself, teach or suggest the claimed step. As neither reference teaches this step, the invention as a whole cannot be considered to be obvious over this combination.

The cited combination does not teach or suggest:

"sending a shipping identifier and an associated address to the shipper, whereby the shipper, after picking up the package for shipment from the vendor, matches the package code sent to the vendor with the shipping identifier and identifies the associated address as the delivery address of the package."

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A buy order is simply not a shipping identifier, it is an order to buy something, and not a proper or reasonable basis for rejecting claim 1. Col. 4, lines 54-58 do not teach sending a shipping identifier and an associated address to the shipper. Moreover, the cited combination of references simply does not teach that the shipper picks up the package from the vendor and matches the package code sent to the vendor with the shipping identifier. Shkedy is silent on the issue of shipping, whereas Wolinsky teaches that all parts are first shipped to a central location (Elmhurst) before being forwarded to their ultimate destination. The cited combination, therefore, cannot be said to teach or to suggest the invention of claim 1, for the foregoing reasons.

INDEPENDENT CLAIM 7

Claim 7 recites:

7. A method of processing a package identified by a package code devoid of delivery address information, the package containing goods purchased by a customer from a vendor for shipment to an address unknown to the vendor, comprising the steps of:

- receiving a request to pick up a package from the vendor, the package having a machine-readable package code affixed thereto, the request including a shipping identifier and a delivery address associated with the shipping identifier;
- picking up the package from the vendor;
- reading the package code affixed to the package;
- matching the package code with the received shipping identifier,

and

- delivering the package to the delivery address associated with the shipping identifier.

In support of the rejection of claim 7, the Office interprets Shkedy's "buy order" as the claimed "request to pick up a package from the vendor". In support of its rejection of claim 1, however, that same "buy order" was interpreted as including the claimed "shipping identifier", at page 3 of the outstanding Office Action. It is clear that the Office is using the applicant's own disclosure as a road map to force unrelated teachings in the cited references to fit the claimed

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invention (to the point of even being internally inconsistent and contradictory). This has been done by ignoring the plain meaning of the cited references and ascribing whatever meaning to the teachings thereof that supports the §103 rejection.

The applicant submits that Shkedy does not teach shipping goods and that Wolinsky never picks up packages from the vendor. The parts, in Wolinsky are shipped to FastParts in Elmhurst by the vendor. However, the outstanding Office Action asserts that Shkedy teaches the limitation of picking up the package from the vendor, and cites "checks with transfer agent" as teaching "picking up the package from the vendor". Checking with a transfer agent does not mean picking up a package. Those of ordinary skill would in no way be motivated to pick up a package from a vendor upon learning of Shkedy's teaching of "checking with a transfer agent". To assert otherwise simply subverts the teachings of Shkedy and eviscerates the underlying purpose of the law of obviousness, as codified at §103 of title 35.

Claim 7 then requires "reading the package code affixed to the package". The Office points to Col. 14, lines 26-51 as teaching this recitation. However, Col. 14, lines 26-51 teaches nothing of the sort. In Shkedy, there is no package, and no reading any package code affixed to the package. The closest thing to a package in Shkedy is the passing mention that stock certificates could be delivered, as noted in Col. 15, lines 19-21.

The Examiner then notes that the package code being devoid of address information is not taught in Shkedy and refers the reader to the flawed rejection of claim 1. The arguments advanced herein relative to claim 1 are, therefore, incorporated herewith.

It is respectfully submitted to the Office that even if machine readable indicia are taught by Wilz, that any reasonable combination of the applied references does not teach or suggest the

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claimed inventions, for the reasons advanced above.

Indeed, the applied combination does not teach or suggest the claimed subject matter in which a shipper receives "a request to pick up a package from the vendor, the package having a machine-readable package code affixed thereto, the request including a shipping identifier and a delivery address associated with the shipping identifier, picks "up the package from the vendor"; reads "the package code affixed to the package", matches "the package code with the received shipping identifier, and" delivers "the package to the delivery address associated with the shipping identifier." These steps cannot be said to be taught or suggested by the applied combination without ascribing teachings to the combination of references that are only present in the present invention.

CLAIM 13

This rejection repeats the Office's assertion that a sell order is the same as the recited "request for a package code". The arguments advanced relative to this assertion above (and those advanced relative to claim 1) are incorporated herewith. In short, however, a sell order is not a request, and especially not a request for a package code.

The Office again points to Col. 14, lines 26-51 as teaching the recited step of "affixing the package code to the package". However, this same passage in Shkedy was also relied on in the outstanding Office Action as teaching "picking up the package from the vendor" (page 6, line 3) and "reading the package code affixed to the package" (page 6, line 6). This passage, for ease of reference, is reproduced below:

"Referring now to FIG. 8, order 100 is received and checked. If sufficient shares are available to cover the quantity of order 100, order 100

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is added to order database 267. At step 800, central controller 200 extracts quantity information from order 100. At step 805, central controller 200 checks with the transfer agent to see if the seller has the shares. In another embodiment, central controller checks the seller's account in customer account database 297 to see if the shares are available. This serves to "lock up" a portion of the available shares in the seller's account, preventing him from selling the same shares twice while order 100 is still active. At step 807, the central controller contacts the transfer agent to see if the seller has the shares. If sufficient shares are not available to cover the quantity of order 100, the seller is requested to transfer more shares into his account at the transfer agent at step 810. Once additional shares have been transferred to the account, central controller 200 then reconfirms the quantity of shares available at the transfer agent at step 80.

If all is well, the order is accepted at step 830. At step 840 a unique tacking number is added to the order 100. The central controller 200 timestamps order 100 at step 850 sets the status to "active" and stores order 100 in the order database 267. The database is exactly the same as described above in the buyer protocol."

This passage contains no teaching of affixing anything to any package. Again, to assert that it does is simply contrary to the plain meaning of the applied reference. To complicate matters, the Office then, on page 8, line 8, states that "Shkedy and Wollinsky collectively fail to expressly teach generates a shipping label ... and affixes the label to the package." The Office Action is, therefore, both in error and internally inconsistent.

The office then points to Col. 4, lines 59-60 as teaching the claimed step of "surrendering the package to a shipper, whereby the shipper matches the package code with a shipping identifier and associated delivery address previously received from the trusted entity". However, Col. 4, lines 59-60 contains:

"scanning the database for matching sell and buy orders; executing trade upon a match;"

Scanning a database for a match and executing the trade upon finding a match does not teach or suggest the claimed language of "surrendering the package to a shipper, whereby the shipper matches the package code with a shipping identifier and associated delivery address

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previously received from the trusted entity". Assertions otherwise run contrary to the plain meaning of the cited reference.

For at least the reasons cited herein, it is respectfully submitted that claim 13 cannot be rendered obvious over the applied combination of references.

CLAIM 18

The storing step is not taught by the Shkedy or by the secondary references, either taken alone or in combination. Indeed, the bank in Shkedy, is limited to the roles holding account information and to issuing digital certificates (see col. 16, lines 14-44). The bank, in Shkedy, does not carry out in the claimed steps of "assigning a package code to the item, the assigned package code being associated with the retrieved delivery address; sending only the package code to the vendor, the vendor affixing the package code to the package, and sending the package code and the associated delivery address to a shipper for storage in a shipper database". The Office is respectfully reminded that the mere fact that Wollinsky teaches anonymous shipment of parts from a central location does not render the claimed invention obvious unless the combination fairly teaches or suggests the invention as a whole, as defined by the recited steps. In this case, the cited combination fails to teach assigning the package code and sending the package code only to the vendor. This is not how Wollinsky describes the FastParts system. Again, Wollinsky at page 2, paragraph 8 only teaches that parts are shipped to a central location whereupon a digital picture is taken of the box. This is the sole means by which buyers and shippers, according to Wollinsky, are kept anonymous. The presently claimed invention is not even hinted at in the applied combination.

Shkedy discloses a system wherein both buyers and sellers independently and anonymously

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register and enter buy and sell orders - see Figs. 5 and 7, respectively and Col. 13, lines 15-20 and Col. 14, lines 21-26. The buyers and sellers are then matched and the transaction allowed to execute. The invention of claim 18 does not work that way. As claimed, once the draft presented by the vendor is honored, the bank assigns a package code to the item, and sends the package code to the vendor and to the shipper. This step is not disclosed or suggested in Shkedy or in the secondary references, either considered singly or in combination. This allows the shipper to match the package code with a previously received (from the bank) package code and delivery address pair. Such matching is not taught by any of the references, taken individually or in combination.

Therefore, even if Shkedy was indeed modified according to the central shipping concepts of Wollinsky, the present invention would not result or somehow emerge therefrom, when none of the references teach or suggest any of the claimed steps. Reconsideration and withdrawal of the §103 rejections applied to claim 18 and its dependent claims are, therefore, respectfully requested.

CLAIM 27

Claim 27 recites sending the vendor a package code and an associated forwarding address and causing the vendor to forward the goods and the package code to the forwarding address. Thereafter, the goods can be matched with the electronic delivery address through the package code at the forwarding address and sent on to the specified ultimate electronic delivery address. Neither Shkedy nor the Wolinsky reference teaches or suggest such a method. Indeed, Shkedy does not teach forwarding anything to the vendor, nor the vendor shipping anything to a forwarding address, whereas Wollinsky only contemplates physical delivery of parts (i.e., non-digital, tangible goods). The applied combination, therefore, would not teach the claimed one or